

Remarks/Arguments

This is responsive to the Office Action mailed April 5, 2006. The amendments and remarks are proper, serve to more particularly point out and distinctly claim that which is patentable over the references of record, do not introduce new matter, do not require additional searching, and are not narrowing in view of a rejection over a cited reference.

In the event the requested reconsideration is not granted, the remarks further serve to explain why this case is not in condition for appeal.

The amendments to claim 1 are made to obviate the standing objection to claim 1 related to the Examiner construing the *moving* step to be subsumed within the *raising* step, and to harmonize the claimed transducer amongst all the claims.

Examiner's Response to Applicant's Arguments

The Examiner provided the following response to Applicant's previous arguments:

Applicant's arguments filed 1/18/2006 have been fully considered but they are not persuasive because the arguments are directed to the new amended claims.
(Office Action of 4/5/2006, pg. 4)

This response is indiscernible. Applicant amended the claims in its 1/18/2006 Response, as explained therein, in order to broaden the claim scope and to more particularly point out and distinctly claim the patentable subject matter. The Examiner apparently deems the arguments unpersuasive simply because the Applicant addressed the current claim language. The Examiner forces the conclusion that arguments drawn to former claim language were expected, which is an absurd conclusion. Applicant also regrets that the Examiner did not grant the telephone interview requested in Applicant's

1/18/2006 Response, believing this issue could have been addressed judiciously by better communication before the final rejection was entered.

Accordingly, the examination resulting in the Office Action of 4/5/2006 is incomplete with regard to the Examiner's obligation to state the reasons for any adverse action so as to aid the Applicant to judge the propriety of continuing the prosecution. 37 CFR 1.104(a)(2) Based on this clearly erroneous reasoning for finding Applicant's arguments not persuasive, Applicant now requests reconsideration and withdrawal of the rejections of all claims.

Claim Objections

Claim 1 stands objected to as being indefinite because "the move cycle routine has being [sic, been] executed whenever the head began to move." (Office Action of 4/5/2006, pg. 2)

The Examiner's construction that the moving step is executed by the raising step is unreasonably broad because it ignores both the plain meaning and the explicit definition and usage in the specification of the claim terms *raising* and *moving*. *In re Morris*, 43 USPQ2d 1753 (Fed. Cir. 1997). That is, the *raising* step and the *moving* step are explicitly recited as separate and distinct steps in the claimed subject matter. However, according to the Examiner's construction they form only one step, with the *moving* step being subsumed within the *raising* step. Such a construction is inconsistent with the specification, such as for example which clearly shows in FIG. 6 and the associated description thereof the *raising* step in block 206 being a condition precedent to the *moving* step of block 210.

Nevertheless, and solely for the purpose of obviating the Examiner's objection, Applicant has amended claim 1 in order to more particularly point out and distinctly claim the *raising* step as occurring *at a radial position* and the *moving* step as occurring *radially*. This amended language obviates the Examiner's concern without narrowing the claim scope. Reconsideration and withdrawal of the objection to claim 1 are respectfully requested.

Rejection Under 35 USC 102

Claim 1 stands rejected as being anticipated by Sasamoto '541. This rejection is respectfully traversed.

The Examiner has again failed to substantiate a prima facie case of anticipation because newly cited Sasamoto '541 also does not identically disclose the claimed subject matter of claim 1, which includes at least the following:

raising a fly height of a read/write head to a maximum setting at a radial position; moving the read/write head radially while substantially at the maximum fly height to a beginning position....
(excerpt of claim 1, emphasis added)

Sasamoto '541 discloses moving the head radially across the disc during motor startup. That is, Sasamoto '541 moves the head across the disc in both radial directions during times when the head is contactingly engaging the disc and during times when the head is at a minimum fly height.

For example, FIG. 6 of Sasamoto '541 shows the nominal fly height is achieved with a disc speed of 40 m/sec:

The magnetic head 7 is at first not floated away from the magnetic disk surface due to the rough surface of the

magnetic disk 3 and the pressing force of a plate spring 20 of the magnetic head 7 against the disk surface until the disk 3 reaches a peripheral speed of 10 m/sec. After it reaches that speed, the head 7 is floated away from the disk surface, and at the steady state of rotation, or peripheral speed of disk 40 m/sec, the head 7 is floated by 0.5 μ m away from the disk surface.

(Sasamoto '541, col. 1 lines 34-43, emphasis added)

Sasamoto '541 discloses reciprocatingly moving the head in both radial directions from the time the disc starts moving until it has been accelerated to about half the nominal velocity:

Referring to FIG. 6, first the power switch is turned on, and the computer 22 permits the spindle motor 5 to rotate and, while it is at low speed, permits the pulse motor 9 to be operated to move the magnetic head 7. At first, it is unknown where the magnetic head 7 is positioned on the magnetic disk 3, and therefore the magnetic head 7 is moved to the outer periphery of the magnetic disk 3 by driving the pulse motor 9 until it is detected by the outer periphery position detecting sensor 21 (see FIG. 1). After being detected, the magnetic head 7 is moved toward the inner periphery, and when it reaches an inner periphery position, it is again moved back to the outer periphery position. It takes 4 to 5 seconds for the spindle motor 5 to start to rotate and for the revolution rate of the magnetic disk 3 to change from a range of small sliding energy to a range of large sliding energy, or speed of 20 m/s. It takes about 0.1 second for the magnet head 7 to once reciprocate over the full tracks. Therefore, the magnetic head 7 can reciprocate 40 to 50 times during the time of 4 to 5 seconds. Detecting that the head 7 has reciprocated 40 to 50 times, the head 7 is stopped from moving.
(Sasamoto '541, col. 3 line 52 to col. 4 line 5, emphasis added)

After reading Sasamoto '541 the skilled artisan would readily recognize that the Examiner mischaracterizes it in stating: "Sasamoto '541 discloses a method in a disk drive for moving the read/write head at a maximum fly height in the beginning position and lowering the read/write head to a minimum fly height as the read/write head moves away

from the beginning position.” (Office Action of 4/5/2006, pg. 2) The passage on which the Examiner relies (Sasamoto ‘451 col. 2 lines 28-42) discusses the curves in FIG. 3 to make the point that at the nominal disc speed a head contact will likely result in damage to the disc to the extent that stored data is lost. The passage does not in any way support the Examiner’s statement.

Again, as in the first action, the Examiner has failed to substantiate a *prima facie* case of anticipation because Sasamoto ‘541 does not identically disclose *raising a fly height of a read/write head to a maximum setting...moving the read/write head radially while substantially at the maximum fly height* as claimed. That means the examination resulting in this rejection is incomplete with regard to the Examiner’s obligation to consider the patentability of the invention as claimed. 37 CFR 1.104(a)(1). Reconsideration and withdrawal of the rejection of claim 1 are respectfully requested.

Absent the requested reconsideration, a Pre-Appeal Brief Panel must find in the underlying facts “substantial evidence” that adequately supports the Examiner’s legal conclusion of anticipation. This approach is consonant with the Office’s obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Only a travesty in equities would require Applicant to proceed to appeal on a rejection based on a mischaracterization of what the cited reference discloses. Accordingly, this case is not in condition for appeal due to the unresolved factual issues that the Examiner has failed to make the requisite evidentiary showing in the record substantiating a

prima facie case of anticipation, and due to the factual mischaracterization of the cited reference.

Rejection Under 35 USC 102

Claims 9-12 and 18-20 stand rejected as being anticipated by McNeil '311. This rejection is respectfully traversed.

Claim 9

The Examiner has again failed to substantiate a prima facie case of anticipation because newly cited McNeil '311 also does not identically disclose the claimed subject matter of claim 9, which includes at least the following:

a control element executing a move cycle routine by steps for associating a spatial separation between the transducer and the storage medium in relation to a direction of moving the transducer across the storage medium.
(excerpt of claim 9, emphasis added)

The passage of McNeil '311 that the Examiner cites explicitly discloses that the spatial separation is the same as the head is moved in both directions across the disc:

there is disclosed a method for cleaning the disc surface and the head comprising loading and flying the head on the disc surface, reducing the spindle motor speed to a speed where the head flies at approximately 50% of the normal flying height, moving the head back and forth across the disc surface, for several cycles, to remove any particles down to an elevation that is 50% of the normal flying height....

(McNeil '311, col. 2 lines 20-27, emphasis added)

McNeil '311 is wholly silent regarding *associating a spatial separation between the transducer and the storage medium in relation to a direction of moving the transducer*

across the storage medium as claimed. The Examiner mischaracterizes the claimed subject matter by completely ignoring this claim feature in stating:

McNeil discloses a data storage device with a transducer and a storage medium along two dimensions with respect to each other in a data transfer relationship and control element that control [sic, controls] the execution of the move cycle routine that [sic] across the storage medium. (Office Action of 4/5/2006, pg. 3)

The passage on which the Examiner relies (McNeil '311 FIG. 1 and col. 2 lines 14-34 and Abstract) consistently disclose sweeping the heads in both directions at the same fly height; see, for another example: "to sweep the heads across the disc surfaces, forward and reverse, for several cycles, to remove any particles down to an elevation that is 50% of the normal flying height." (McNeil '311 Abstract, emphasis added) These passages do not in any way support the Examiner's statement.

Applicant reiterates that the Examiner has again refused to construe claim 9 in accordance with 35 U.S.C. §112, sixth paragraph. The Applicant has identified the function associated with the recited "steps for" element as being associating the fly height with the radial direction of the transducer, such as during sweep cycles clearing debris. The Examiner is obliged as a matter of law to construe this steps-for element as the disclosed acts, and equivalents thereof, that are capable of the identical function. See *B. Braun Medical, Inc. v. Abbott Lab.*, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997); *In re Donaldson Co. Inc.*, 26 USPQ2d 1845 (Fed. Cir. 1994)(*en banc*); *In re Dossel*, 42 USPQ2d 1881 (Fed. Cir. 1997); *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, Para. 6*, 65 FR 38510. The Examiner's repeated failure to do so is clearly reversible error.

Again, as in the first action, the Examiner has failed to substantiate a *prima facie*

case of anticipation because McNeil '311 does not identically disclose *steps for associating a spatial separation between the transducer and the storage medium in relation to a direction of moving the transducer* as claimed. That means the examination resulting in this rejection is incomplete with regard to the Examiner's obligation to consider the patentability of the invention as claimed. 37 CFR 1.104(a)(1). Reconsideration and withdrawal of the rejection of claims 9 and the claims depending therefrom are respectfully requested.

Absent the requested reconsideration, a Pre-Appeal Brief Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's legal conclusion of anticipation. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Only a travesty in equities would require Applicant to proceed to appeal on a rejection based on a mischaracterization of what the claim recites and a reticent refusal to construe it in accordance with Section 112 paragraph six, and based on a mischaracterization of what the cited reference discloses. Accordingly, this case is not in condition for appeal due to the unresolved factual issues that the Examiner has failed to make the requisite evidentiary showing in the record substantiating a prima facie case of anticipation, and due to the factual mischaracterization of the recited claim language, and due to the factual mischaracterization of the cited reference, and due to the unresolved legal issues associated with the reticent refusal to construe the claim in accordance with Section 112 paragraph six.

Claim 18

The Examiner has again failed to substantiate a prima facie case of anticipation because McNeil '311 does not identically disclose the claimed subject matter of claim 18 which includes at least the following:

An apparatus comprising circuitry configured to spatially separate a transducer from a storage medium by a first separation that is greater than a nominal data transfer separation, to thereafter move the transducer adjacent a selected portion of the storage medium at the first separation, to thereafter lower the transducer to a second separation that is less than the nominal data transfer separation, and to thereafter move the transducer across the storage medium at the second separation.
(excerpt of claim 18, emphasis added)

The Examiner's rejection was based on the same reasoning for independent claims 9 and 18. As above for claim 9, the passage of McNeil '311 that the Examiner cites explicitly discloses that the spatial separation is the same as the head is moved in both directions across the disc. McNeil '311 is wholly silent regarding *move the transducer adjacent a selected portion of the storage medium at the first separation...move the transducer across the storage medium at the second separation* as claimed. The Examiner mischaracterizes the claimed subject matter by completely ignoring this claim feature. The passages on which the Examiner relies consistently disclose sweeping the heads in both directions at the same fly height. These passages do not in any way support the Examiner's statement.

Again, as in the first action, the Examiner has failed to substantiate a prima facie case of anticipation because McNeil '311 does not identically disclose *move the transducer adjacent a selected portion of the storage medium at the first separation...move the transducer across the storage medium at the second separation* as claimed. That means the

examination resulting in this rejection is incomplete with regard to the Examiner's obligation to consider the patentability of the invention as claimed. 37 CFR 1.104(a)(1). Reconsideration and withdrawal of the rejection of claim 18 and the claims depending therefrom are respectfully requested.

Absent the requested reconsideration, a Pre-Appeal Brief Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's legal conclusion of anticipation. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Only a travesty in equities would require Applicant to proceed to appeal on a rejection based on a mischaracterization of what the claim recites, and based on a mischaracterization of what the cited reference discloses. Accordingly, this case is not in condition for appeal due to the unresolved factual issues that the Examiner has failed to make the requisite evidentiary showing in the record substantiating a prima facie case of anticipation, and due to the factual mischaracterization of the recited claim language, and due to the factual mischaracterization of the cited reference.

Conclusion

This is a complete response to the Office Action mailed April 5, 2006. The Applicant requests reconsideration and withdrawal of all rejections.

The Applicant has also included herewith another request for telephone interview with the Examiner and his supervisor to clarify the unresolved issues detailed herein.

The Examiner is invited to contact the Attorneys listed below should any questions arise concerning this response or request for interview.

Respectfully submitted,

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